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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/846,940

04/30/2001

Jerry A. Volquardsen

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10/19/2006

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DES MOINES, IA 50309-2721

EXAMINER

FISHER, MICHAEL J

ART UNIT

PAPER NUMBER

3629

DATE MAILED: 10/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/846,940

Applicant(s)

VOLQUARSEN ET AL.

Examiner

Michael J. Fisher

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 8-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 8-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 8,9 and 14-51 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 8 and 9 recite the limitation "claim 7" in line 1 of each. There is insufficient antecedent basis for this limitation in the claim.

Note: for examination purposes, the examiner will assume that these claims depend from claim 5, as claim 7, before it was canceled, was dependent on claim 5.

As to claims 14,26,45 and 51, there is disagreement between the preamble and the body of the claims, thus rendering the scope of the claims unclear and indefinite. Specifically, the preambles claim, "for estimating cost of..." while in the body of these, and their dependent claims, there is no limitation that would enable this.

Claims 27-44 and 46-50 are rejected as depending from a rejected claim.

Note: While claim 14 claims "an estimation report" there is no structure that makes this an estimation of the cost. From the limitations, it could "estimate" any number of things about the dents as there is no mention of cost anywhere except the preamble.

Claim Rejections - 35 USC § 103

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-5 and 8-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over US PAT 6,219,930 to Reid.

As to claim 1 Reid discloses a method of estimating cost of dent repair (title), which includes gathering data (inherent in that the data is gathered), processing the information according to a pre-existing estimation program (claim 1, last two paragraphs), generating an estimate of repair costs (title), characterizing the size of the dents (col 3, lines 26-31) and identifying and characterizing a cluster (col 2, lines 53-64, col 4, line 66-col 5, line 8).

Reid does not, however, teach using this system for paintless dent repair (PDR) or specifically mention that the computer would do the calculating. It would have been obvious to one of ordinary skill in the art to use the system as disclosed by Reid for

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PDR as Reid teaches it as a good way to estimate the cost of dent repair and PDR is repairing dents. Further, Reid teaches using equations (col 5, lines 50-55) therefore, it would have been obvious to one of ordinary skill in the art to use the computer to calculate the cost as computers are very well known to be useful in calculating the results of equations.

As to claim 2, Reid discloses using stored digital data (col 4, lines 25-34).

As to claim 3, Reid does not teach using a global computer network. Reid does teach using computers (col 4, lines 25-34) and it is very well known in the art to connect computers to a global computer network (the Internet). Therefore, it would have been obvious to one of ordinary skill in the art modify the system as disclosed by Reid by using the Internet to ease access to the information.

As to claims 4,20, Reid does not teach confirming that the damage is susceptible to PDR. It would have been obvious to one of ordinary skill in the art to confirm this as the system is being used for PDR and therefore, it would be inherent that the user knows if the dents can be fixed using PDR.

As to claims 8, as best understood, and 21, Reid discloses confirming the cluster is contained in a predetermined area (the template) and counting the number of dents (col 3, lines 14-16).

As to claims 9, as best understood, and 22, Reid discloses using the range of dent sizes and cluster information to estimate total cost of repairs for the vehicle (as discussed above, Reid discloses using dent size and cluster information and further discloses estimating cost in col 6, lines 11 and 12).

As to claims 10,23, Reid discloses manually counting damage and using that information to generate a repair estimation (claim 1).

As to claims 12,25, Reid does not teach using the Internet to request a web page hosted by a web server. Reid does teach using computers (col 4, lines 25-34) and it is very well known in the art to connect computers to a global computer network (the Internet). Therefore, it would have been obvious to one of ordinary skill in the art modify the system as disclosed by Reid by using the Internet to ease access to the information and further, it is inherent that Internet sites are web pages hosted by a web server.

As to claim 13, Reid discloses completing a data input template (col 4, lines 52-54).

As to claims 14,24, Reid further discloses a computer input adapted to digitally store information about body damage (fig 5), and to generate an estimation report based on inputted data (col 4, line 67- col 5, line 2).

As to claim 15, Reid does not, however, disclose two computers, Reid discloses only one computer. As is well settle in case law, duplication of parts is well within purview of one of ordinary skill in the art (see St. Regis Paper Co. v. Bemis Co., Inc. 193 USPQ 8,11 (7th Cir. 1977)). Therefore, it would have been obvious to one of ordinary skill in the art to use two computers to have a central storage of information to reduce the chance of losing data.

As to claim 16, the template has indicia to prompt recordation of certain information (col 4, lines 3-4).

As to claim 17, the worksheet is physical.

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As to claims 18 and 19, the worksheet is shown to be displayable on a computer (col 4, lines 30-34).

As to claim 26, Reid discloses a hand carryable and manipulatable device (template) which has a length, width and thickness (as is inherent in three dimensional objects), a plurality of openings in the device (fig 3), one of which could be characterized as a "further" opening that would meet the limitations as claimed as the openings are used to estimate clusters of dents. Reid does not, however, teach using this system for painless dent repair (PDR). It would have been obvious to one of ordinary skill in the art to use the system as disclosed by Reid for PDR as Reid teaches it as a good way to estimate the cost of dent repair and PDR is repairing dents Further, Reid discloses gauging the size of the dents (col 4, lines 13-18) and further, if the system is to be used for PDR it would be inherent that the dents are identified as being proper for PDR and not too small or too large.

As to claim 27, the device is shown as a sheet of material (col 3, lines 57-59).

As to claim 28, it is shown to be flexible (col 3, lines 57-59).

As to claims 29 and 30, the make up of the template is considered to be an obvious matter of design choice, therefore, it would have been obvious to one of ordinary skill in the art to use paper, or laminated paper, to make the template as this would be inexpensive and would not make losing a template too costly.

As to claim 31, the template is shown to be plastic (col 3, lines 8-9).

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As to claims 32,46, the make up of the template is considered to be an obvious matter of design choice, therefore, it would have been obvious to one of ordinary skill in the art to use regular, letter-sized paper, as this is cheap and abundant.

As to claim 33, Reid discloses indicia identifying the plurality of openings (54).

As to claim 34, it would be inherent that areas are arranged next to each other and that the next area would be closest to the preceding.

As to claim 35, the size of the openings is considered to be an obvious matter of design choice (In re Rose, 105 USPQ 347 (CCPA 1965)) and therefor is not considered to be patentably distinct.

As to claims 36,27, Reid discloses an opening larger than the other openings (fig 2 compared to fig 3).

As to claim 37, Reid discloses using a representative area to estimate total dents (col 3, lines 18-25).

As to claim 38, Reid discloses the dents as being hail damage (col 2, lines 59-61).

As to claim 39, the template would project the openings onto a vehicle (by placing it on the vehicle).

As to claim 40, Reid discloses the device as using light (scanner 60).

As to claim 41, the device is a plurality of devices (templates) each with openings (figs 2 and 3).

As to claim 42, Reid does not teach adjustable openings. Reid does teach a need for different sized openings (col 4, lines 13-18), it would have been obvious to one

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of ordinary skill in the art to have adjustable openings in a template that is not transparent, as in that example, as Reid discloses templates that are not transparent (fig 3), and Reid further discloses needing to know the various sizes of the dents.

As to claim 43, Reid discloses a worksheet (equations at col 5, lines 50-56).

As to claim 44, the worksheet could be electronic (col 36-41).

As to claim 45, Reid further discloses a recording medium (computer and scanner) having indicia prompting a user to record a set of identifying information about the vehicle (this would be inherent as the computer would need to know which car was being scanned) and further, a set of information about the damage to the vehicle (dent size and number).

As to claim 48, it would have been obvious to one of ordinary skill in the art to provide an instruction sheet so the user could know how to use the template properly.

As to claim 49, Reid discloses providing a plurality of dent estimation methods (equations, col 5, lines 50-55).

As to claim 50, Reid discloses counting dents using the templates (claim 1).

As to claim 51, it would have been obvious to one of ordinary skill in the art to get clients to use the system as taught by Reid as Reid shows it as a good way to estimate damage and businesses require clients. Further, it would be inherent that the access to the information would be dependent on a level of authorization, whether allowed or not allowed, according to whether one is a customer or not, i.e. paying compensation.

Response to Arguments

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Applicant's arguments with respect to the rejection under 35 USC 101 have been fully considered and are persuasive. This rejection has been withdrawn.

Applicant's arguments filed 9/25/06 have been fully considered but they are not persuasive. As discussed above, the prior art does teach characterizing the size of the dents. While the claims must be considered in light of the specification, nowhere in the claims is there a limitation concerning a "highest concentration" and using this to estimate the cost. Further, Reid does teach taking a representative sample and extrapolating out to cover an entire panel (col 5 lines 12-65), thus meeting the limitations as claimed. As for claim 51, to have a business is old and well known in the art, claim 51 does not have limitations that would distinguish it over any other business providing a service.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Fisher whose telephone number is 571-272-6804. The examiner can normally be reached on Mon.-Fri. 7:30am-5:00pm alt Fri. off.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Michael Fisher



Patent Examiner
GAU 3629

MF 
10/11/06